

FERNALD LAW GROUP LLP
BRANDON C. FERNALD (BAR NO. 222429)
PAUL W. SANDE (BAR NO. 296357)
510 W. 6th St., Suite 700
Los Angeles, CA 90014
Telephone: (323) 410-0300
Facsimile: (323) 410-0330
Email: brandon@fernaldlawgroup.com
paul@fernaldlawgroup.com

Attorneys for Plaintiff TAP WORLDWIDE, LLC

**IN THE UNITED STATES DISTRICT COURT
FOR THE CENTRAL DISTRICT OF CALIFORNIA**

TAP WORLDWIDE, LLC, a
Delaware limited liability company,

Plaintiff,

v.

ONYX SALES & MARKETING
INC., a California corporation,
JUSTIN ZEV, an individual, and
DOES 1-10, inclusive,

Defendants.

CASE NO.: _____

**COMPLAINT FOR DAMAGES
AND INJUNCTIVE RELIEF FOR:**

- (1) **FEDERAL TRADEMARK
INFRINGEMENT**
- (2) **FALSE DESIGNATION OF
ORIGIN**
- (3) **FEDERAL TRADEMARK
DILUTION**
- (4) **COMMON LAW
TRADEMARK
INFRINGEMENT**
- (5) **STATUTORY UNFAIR
COMPETITION**

DEMAND FOR JURY TRIAL

1 Plaintiff TAP Worldwide, LLC (“TAP Worldwide”) alleges as follows:

2 **INTRODUCTION**

3 1. TAP Worldwide is a leading national and international manufacturer,
4 distributor and retailer of aftermarket automotive and truck parts and accessories.
5 TAP Worldwide and its predecessors have spent many years and a significant sum
6 of money marketing and advertising the XRC mark in connection with aftermarket
7 hardware for trucks and SUVs. As a result, the XRC brand and trademark (the “XRC
8 Mark”) has come to be associated by the trade and consuming public alike with high
9 quality, innovative products manufactured and supplied by TAP Worldwide and its
10 affiliates, including Smittybilt (“Smittybilt”). Defendant Onyx Sales & Marketing
11 Inc. and Justin Zev (“Defendants”) recently began using “XRC” in connection with
12 the marketing and sale of their own aftermarket SUV and truck parts and accessories.
13 In so doing, Defendant has and is engaging in trademark infringement and unfair
14 competition in violation of Federal and State law.

15 **THE PARTIES**

16 2. Plaintiff TAP Worldwide is a limited liability company organized under
17 the laws of Delaware, with its principal place of business in Compton, California.

18 3. Upon information and belief, Onyx Sales & Marketing Inc. is a
19 corporation organized under the laws of California, with its principal place of
20 business in Santa Ana, California.

21 4. Upon information and belief, Justin Zev is, and at all times relevant was,
22 a citizen of California residing in Newport Beach, California.

23 5. TAP Worldwide is ignorant of the true names and capacities of the
24 defendants sued in this Complaint as Does 1 through 10, inclusive, and therefore sues
25 these defendants by such fictitious names. TAP Worldwide will amend this
26 Complaint to allege the true names and capacities of the Doe defendants when
27 ascertained. Each of the fictitiously named defendants is responsible in some manner
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1 for the conduct alleged in this Complaint, and TAP Worldwide's damages are
2 actually and proximately caused by the conduct of such defendants.

3 **JURISDICTION AND VENUE**

4 6. This Court has jurisdiction over the subject matter of this action under
5 15 U.S.C. § 1121, 28 U.S.C. §§ 1331 and 1338(a) and (b), and has supplemental
6 jurisdiction under 28 U.S.C. §§ 1367(a) over Plaintiff's state law claims.

7 7. Venue is proper under 28 U.S.C. § 1391(b) because a substantial part of
8 the events or omissions giving rise to the claim occurred in the Central District of
9 California.

10 **ALLEGATIONS COMMON TO ALL CAUSES OF ACTION**

11 8. TAP Worldwide is a leading national supplier of automotive and off-
12 road parts and accessories headquartered in Compton, California. Over several
13 decades, TAP Worldwide has created and/or acquired several unique lines of branded
14 products including ProComp (www.procompusa.com) and Smittybilt
15 (www.smittybilt.com), to name only a few.

16 9. TAP Worldwide has utilized the XRC Mark in interstate commerce,
17 continuously, since at least 2007, in conjunction with the marketing and sale of
18 aftermarket truck and SUV parts and accessories. TAP Worldwide and its
19 predecessors have invested a significant sum of monies over the years advertising
20 and promoting the XRC Mark.

21 10. TAP Worldwide is the owner of a federal trademark registration for the
22 XRC Mark, U.S. Reg. No. 3,541,089. A true and accurate copy of the registration
23 certificate is attached hereto as Exhibit A.

24 11. As a result of TAP Worldwide's and its predecessors' significant
25 investment in the XRC Mark, the XRC Mark has earned prominent brand recognition
26 and substantial good will.

27 12. As a result of TAP Worldwide's and its predecessors' continuous use of
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1 the XRC Mark over the past 8 years, the mark has obtained strong secondary meaning
2 indicating source with respect to products and services in the aftermarket SUV and
3 truck parts and accessories market.

4 13. TAP Worldwide's registration is valid and enforceable pursuant to 15
5 U.S.C. § 1057.

6 **DEFENDANTS' INFRINGING ACTIVITIES**

7 14. Upon information and belief, Defendants sell aftermarket SUV and
8 truck accessories and parts.

9 15. In or about January, 2015 TAP Worldwide became aware of the fact that
10 Defendants have been marketing and selling aftermarket automotive parts that are
11 identical to parts sold by TAP Worldwide and identifying said parts as "XRC Style"
12 parts.

13 16. Defendants market and sell these so called "XRC Style" products on
14 Ebay.com® and Amazon.com® as well as through their own e-commerce website
15 called www.truckandwinch.com.

16 17. Defendants had engaged in similar infringing activities in 2012 and as a
17 result TAP Worldwide caused two cease and desist letters to be sent to Defendants
18 in January 2012 and then May 2012 with respect to Defendant's infringing use of the
19 XRC Mark.

20 18. Thereafter, Defendants ceased use of the XRC Mark.

21 19. However, Defendants are now once again employing the XRC Mark in
22 connection with the marketing and sale of aftermarket SUV and truck accessories.

23 20. Defendants' willful refusal to cease and desist their use of Plaintiff's
24 trademarks or to take any other reasonable steps to avoid confusion necessitates that
25 this lawsuit proceed.

26 **FIRST CLAIM FOR RELIEF**

27 **(Federal Trademark Infringement, 15 U.S.C. § 1114)**

1 21. TAP Worldwide realleges and incorporates by references the allegations
2 contained in Paragraphs 1 through ___ as through fully set forth herein.

3 22. Defendants' line of infringing products are marketed through the same
4 channels of trade and to the same customers that TAP Worldwide sells its products.

5 23. Defendants' improper use of the XRC Mark is likely to cause actual
6 confusion or to cause mistake, or to deceive consumers as to the origin, sponsorship
7 or approval of Defendants' products, or is likely to cause consumers to believe that
8 Defendants and TAP Worldwide are somehow affiliated, connected or associated
9 with each other when, in fact, they are not.

10 24. Defendants' use of the XRC Mark is without the permission, license or
11 authority of TAP Worldwide, and constitutes a use in commerce.

12 25. Defendants were aware of TAP Worldwide's use of the XRC Mark in
13 commerce when it engaged in said infringing activities, and did so in order to trade
14 on and receive the benefit of the goodwill built up by TAP Worldwide and its
15 predecessors at great labor and expense over many years.

16 26. The acts of Defendants complained of herein constitute infringement
17 due to false designation of origin, approval or sponsorship of the XRC Mark in
18 violation of 15 U.S.C. § 1114.

19 27. The acts of Defendants described herein have been willful and in bad
20 faith, bringing this a case within the meaning of 15 U.S.C. § 1117(a).

21 28. The acts of Defendants have caused irreparable injury to TAP
22 Worldwide and to the trade and/or consuming public and, unless restrained by this
23 Court, will continue to cause irreparable injury to TAP Worldwide and to the trade
24 and/or consuming public. There is no adequate remedy at law for this injury.

25 29. TAP Worldwide has been damaged by the acts of Defendants in an
26 amount to be proven at trial.

SECOND CLAIM FOR RELIEF

(False Designation of Origin, 15 U.S.C. § 1125(a))

30. TAP Worldwide realleges and incorporates by reference the allegations contained in Paragraphs 1 through __ as though fully set forth herein.

31. Defendants have deliberately and willfully exploited the goodwill that TAP Worldwide and its predecessors have accumulated in the XRC Mark by using them to sell a competing line of infringing products. Defendants' use in commerce of the XRC Mark constitutes false designation of origin as their use is false and misleading to consumers, is likely to cause confusion, to cause mistake, and/or to deceive the trade and/or consuming public as to affiliation, connection or association of Defendants with TAP Worldwide.

32. As a result of their acts as alleged herein, Defendants have violated Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

33. The acts of Defendants described herein have been willful and in bad faith, making this an exceptional case within the meaning of 15 U.S.C. § 1117(a).

34. The acts of Defendants have caused irreparable injury to TAP Worldwide and to the trade and/or consuming public and, unless restrained by this Court, will continue to cause irreparable injury to TAP Worldwide and to the trade and/or consuming public. There is no adequate remedy at law for this injury.

35. TAP Worldwide has been damaged by the acts of Defendants in an amount to be proven at trial.

THIRD CLAIM FOR RELIEF

(Federal Dilution By Blurring, 15 U.S.C. § 1125(c))

36. TAP Worldwide realleges and incorporates by reference the allegations contained in Paragraphs 1 through __ as though fully set forth herein.

37. The XRC Mark is highly recognizable in the trade and amongst the consuming public and are thus famous and entitled to protection against dilution by blurring.

1 38. The XRC Mark is inherently distinctive and has become synonymous
2 with the sale of aftermarket automotive and truck parts and accessories through
3 several years of use and millions of dollars in advertising.

4 39. There is a high degree of similarity between the XRC Mark and the mark
5 used by Defendants.

6 40. Upon information and belief, Defendants have advertised, promoted and
7 sold products under the XRC Mark, or similar variations thereof, and continues to do
8 so, with the intent to create an association between itself and the XRC Mark.

9 41. Defendants' actions have caused and will continue to cause confusion,
10 to cause mistake, and/or to deceive the trade and/or consuming public as to affiliation,
11 connection or association of Defendants with TAP Worldwide and/or as to origin,
12 sponsorship, or approval of services provided by TAP Worldwide and Defendants,
13 in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

14 42. The acts of Defendants described herein have been willful and in bad
15 faith, making this an exceptional case within the meaning of 15 U.S.C. § 1117(a).

16 43. The acts of Defendant has caused irreparable injury to TAP Worldwide
17 and to the trade and/or consuming public and, unless restrained by this Court, will
18 continue to cause irreparable injury to TAP Worldwide and to the trade and/or
19 consuming public. There is no adequate remedy at law for this injury.

20 44. TAP Worldwide has been damaged by the acts of Defendants in an
21 amount to be proven at trial.

22 **FOURTH CLAIM FOR RELIEF**

23 **(Common Law Trademark Infringement)**

24 45. TAP Worldwide realleges and incorporates by reference the allegations
25 contained in Paragraphs 1 through __ as though fully set forth herein.

26 46. The acts of Defendants complained of herein constitute trademark
27 infringement in violation of the common law of California.
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1 47. The acts of Defendants described herein have been willful and in bad
2 faith.

3 48. The acts of Defendants described herein have caused irreparable injury
4 to TAP Worldwide and to the trade and/or consuming public and, unless restrained
5 by this Court, will continue to cause irreparable injury to TAP Worldwide and to the
6 trade and/or consuming public. There is no adequate remedy at law for this injury.

7 49. TAP Worldwide has been damaged by the acts of Defendants in an
8 amount to be proven at trial.

9 **FIFTH CLAIM FOR RELIEF**

10 **(Statutory Unfair Competition, Cal. Bus. & Prof. Code §§ 17200, *et seq.*)**

11 50. TAP Worldwide realleges and incorporates by reference the allegations
12 contained in Paragraphs 1 through __ as though fully set forth herein

13 51. Defendants' conduct as alleged herein constitutes unfair competition in
14 that such acts were and are unlawful, unfair, deceptive and/or fraudulent business
15 acts or practices in violation of California Business & Professions Code §§ 17200, *et*
16 *seq.*

17 52. As a direct and proximate result of Defendants wrongful conduct, TAP
18 Worldwide has suffered injury in fact, which injuries include damage to TAP
19 Worldwide's goodwill and potential customers. Defendants' conduct has also caused
20 damage to the trade and/or consuming public.

21 53. Defendants' wrongful conduct has proximately caused and will
22 continue to cause TAP Worldwide substantial injury, including loss of potential
23 revenues, dilution of goodwill, confusion of potential partners and customers, and
24 diminution of the value of TAP Worldwide's products.

25 54. The harm that Defendants' continued wrongful acts will cause to TAP
26 Worldwide is both imminent and irreparable, and the amount of damage sustained
27 by TAP Worldwide will be difficult to ascertain if the acts continue. TAP Worldwide
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1 has no adequate remedy at law. TAP Worldwide is therefore entitled to an injunction
2 restraining Defendants, their agents, employees, and all persons acting in concert
3 with them from engaging in further such unlawful and wrongful conduct.

4 **JURY DEMAND**

5 55. Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, TAP
6 Worldwide requests a jury trial of all issues that may be tried to a jury in this action.

7 **PRAYER FOR RELIEF**

8 WHEREFORE, TAP Worldwide prays for an Order and Judgment as follows:

9 1. Defendants, its officers, agents, servants, employees, attorneys, and all
10 those persons in active concert or participation with them be preliminarily and
11 permanently enjoined from:

- 12 a. Using the XRC Mark (or any variation thereof, whether alone or
13 in combination with any other word(s) or element(s)), or any
14 mark, name, domain name, or other designation which depicts,
15 contains, or consists of any name or mark confusingly similar to
16 the XRC Mark);
- 17 b. Otherwise infringing on the XRC Mark;
- 18 c. Causing actual confusion, a likelihood of confusion, injury to
19 TAP Worldwide's goodwill, reputation, and proven business
20 success, and/or dilution or blurring of the distinctiveness of the
21 XRC Mark;

22 2. An order, pursuant to 15 U.S.C. § 1118, requiring Defendants to
23 preserve through trial and then deliver to the Court for destruction, or show proof of
24 destruction of, any and all Internet webpages / scripts / html code, articles, products,
25 labels, signs, prints, advertisements, signage, building design(s), packages, wrappers,
26 catalogs, internet web pages, and any other materials in its possession or control
27 bearing or depicting the XRC Mark (or any variation thereof, whether alone or in
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1 combination with any other word(s) or element(s));

2 3. An order requiring Defendants to take all steps necessary to cancel any
3 state or local business registrations, including corporate name registrations and dba
4 filings, that include any of the XRC Mark or amend those registrations to names that
5 do not include any of the XRC Mark, and to remove any references to any business
6 registrations, including corporate names and dba filings, that include the XRC Mark;

7 4. An order requiring Defendants to retain and disclose all
8 communications with all individuals and entities with whom they engaged in any
9 transaction relating to or arising from the use of the XRC Mark names or marks, or
10 otherwise in furtherance of the scheme alleged herein;

11 5. An accounting be directed to determine the profits of Defendants
12 resulting from the activities complained of herein, and that such profits be paid to
13 TAP Worldwide, increased as the Court finds to be just under the circumstances of
14 this case;

15 6. An order directing Defendants, pursuant to 15 U.S.C. § 1116(a), to file
16 with this Court and serve on TAP Worldwide within thirty (30) days after service of
17 an injunction, a report in writing under oath, setting forth in detail the manner and
18 form in which Defendants have complied with the injunction;

19 7. TAP Worldwide be awarded treble damages pursuant to 15 U.S.C. §
20 1117;

21 8. TAP Worldwide be awarded its costs and fees related to this action,
22 including but not limited to, reasonable attorney's fees;

23 9. An order requiring Defendants to pay a judgment for enhanced damages
24 under 15 U.S.C § 1117;

25 10. TAP Worldwide be awarded prejudgment and post-judgment interest;
26 and

27 11. TAP Worldwide be granted such other and further relief, in law or in
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1 equity, as the Court may deem just and proper.

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3 DATED: February 18, 2015

FERNALD LAW GROUP LLP
BRANDON C. FERNALD
PAUL W. SANDE

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5
6 By: /s/ Brandon C. Fernald

7 BRANDON C. FERNALD

8 Attorneys for Plaintiff
9 TAP WORLDWIDE, LLC
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